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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,431	10/12/2001	Louis B. Paludi	1095_001CON	1032

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EXAMINER

ENATSKY, AARON L

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 02/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,431

Applicant(s)

PALUDI, LOUIS B. 3

Examiner

Aaron L Enatsky

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3713

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment on 12/02/02. The arguments set forth in the response are addressed herein below.

Claim Suggestions

Claims 1, 11, 12, and 22 contain grammatical errors that render the claim difficult to read. The claims contain the method or the means for establishing a winning condition in the last section of the claims. Examiner can ascertain the general scope, but the language needs to be rewritten to properly show how a winning condition is determined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by US Patent No. 6,135,885 to Lermusiaux (Ler). Ler teaches of a video game machine containing a library of a plurality of non-identical images that illustrate situations occurring at different times during an event (2:29-32). The library is defined as a plurality of pre-recorded sports plays made by actual players. Furthermore, a video image comprises a plurality of non-identical images, which are shown in sequence, where each displays at different times. To make a coherent video sequence, a first image must be designated for a first frame, a second image must be designated for a second

Art Unit: 3713

frame, and subsequent images would follow suit. A winning condition on the display is depicted as a touchdown or a field goal (2:34-37).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-2, 4, 6-15, 17-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Roffman '568 (Hereinafter, Roff). Roff teaches a video slot machine, with fewer or more than three reels (8:29-30 and Fig. 3-3B). Roff teaches, as is old and well known in the art, that reels comprise a series of identical and non-identical images defining a library of images, where each turn on a slot machine produces a different event (8:19-44). Roff's images comprise different game events that occur at different sequential times during an event (9:14-22, 10:60-67). Roff also teaches an arrangement of a plurality of frames for displaying video images to define an event (Fig. 3A), the video slot machine game embodies various different sport themes of any type including football (7:57-67), and the video slot machines incorporate game features based upon associated theme (8:1-18).

In regard to the provision of a second game stemming from a first game, Roff discloses a first and second payout scheme which are directly linked to different winning conditions of different games (1:66-2:14).

Art Unit: 3713

In regard to the secondary winning condition comprising a football scoring play, Roff teaches that if a player has scored a touchdown and no quarterback is assigned to the player's team, then the player becomes quarterback and a new game is then configured where the second winning condition differing from the initial winning condition lies in that a quarterback must be assigned to win the ensuing game/payout (12:19-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roff.

Roff teaches the claimed limitation as mentioned above, but does not specifically mention a game with an associated race activity. However Roff does teach that a video slot game can comprise any sport (7:65-66). As Roff teaches of a variety of sport games including the provision of any type of sport game, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the sport theme to include a race game.

In regard to using a diagonal pay line to depict a win, it is old and well known to use diagonal pay lines in multiple line, matrix display game machines. Therefore, it is considered well within the capabilities of one of ordinary skill to modify Roff's matrix game display, to determine a winning event based upon a diagonal pay line in a matrix game display.

Response to Arguments

Art Unit: 3713

Applicant's arguments filed 12/02/02 have been fully considered but they are not persuasive.

Arguments regarding the 102 rejections of claims 1-3 are moot in view of the new rejection.

Arguments regarding “a plurality of series of non-identical images illustrating situations occurring at different sequential times during an event” are not persuasive. Examiner contends that Roff continues to read on prior art as Roff displays non-identical images illustrating situations such as a baseball or football sports game (9:1-10:55 and 10:56-12:51), or a race game (15:60-18:58). In a football game, for instance, the different images depict different game plays such as a 4 yard pass, which can be made in combination with one or more plays to create an event with the potential to lead to a winning condition. Applicant's arguments regarding the reels described by Roff, being no more than thematic, is incorrect.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3713

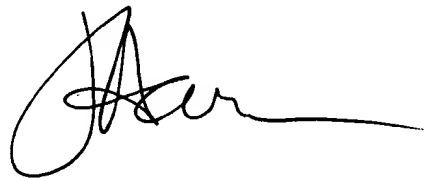
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Aaron Enatsky
February 12, 2003

A handwritten signature in black ink, appearing to read 'Jessica Harrison', with a long horizontal line extending to the right.

**JESSICA HARRISON
PRIMARY EXAMINER**